

**REMARKS**

Applicant thanks the Examiner for the opportunity of an in person examiner interview conducted January 16, 2003.

Claims 12-14 are added. Therefore, claims 1-14 are the claims pending in the Application.

Claim 9 is amended to make it depend from claim 8.

***Rejection of Claims 1-4 and 6-11 Under 35 U.S.C. § 103(a)***

The Examiner rejected claims 1-4 and 6-11 under 35 U.S.C. § 103(a) as being unpatentable over Sussman (U.S. Patent No. 5,483,586), in view of Peterson (U.S. Patent No. 5,509,049). This rejection is traversed.

Claims 1, 8 and 11 require a first channel for voice transmission and a second channel for data transmission, and transmitting a telephone number in the form of a numeric string on the second channel. Further, claim 10 requires a first channel for voice transmission and a second channel for data transmission, and receiving on the second channel a telephone number in the form of a numeric string.

The Examiner acknowledges that Sussman, the primary reference, does not disclose a first channel for voice transmission and a second channel for data transmission. However, the Examiner alleges that since Peterson, the secondary reference, discloses an ISDN line, the D channel in an ISDN can carry data in addition to the control and signaling information for which

it is conventionally configured, and therefore it is inherent that the D channel of an ISDN line carry data.

Peterson does not disclose or suggest transmitting a telephone number in numeric string form over the second channel, as required by Applicant's claimed invention. The Examiner does not allege that Peterson discloses or suggests such a feature. Rather, the Examiner alleges merely that Peterson discloses an ISDN line and that it is inherent that the D-channel in an ISDN line can carry data in addition to control and signaling information. Therefore, the Examiner alleges that Peterson has a channel which is capable of carrying data.

Peterson does not disclose or suggest such a feature in a process or system in which a first channel is for voice transmission and the second channel is for data transmission. Further, Peterson does not disclose or suggest transmitting a telephone number in numeric string form over the second channel. The Examiner does not state how, in his view, Peterson or the prior art disclose or suggest this feature of Applicant's claimed invention.

Inherency requires that "the missing descriptive matter is necessarily present" in the disclosure, and that a person of ordinary skill in the art would recognize that this is so, not merely that the disclosed method or system be capable of performing the function. MPEP §2163.07(a) (underline added). The Examiner does not allege that the cited missing features are necessarily present in Peterson and the prior art. Further, it is submitted that a person of ordinary skill in the art would not have recognized the cited missing features to be necessarily present in the Peterson reference and the prior art. Therefore, the argument of inherency is misplaced and fails to provide a *prima facie* case of obviousness. In fact, Peterson discloses specifically using

**PRELIMINARY AMENDMENT**

U.S. Application No. 09/199,320

**Q51986**

the D channel as a control and signaling channel, as conventionally used (Peterson, col. 7, lines 32-37), and not for transmitting data, as alleged.

Further, claim 4 requires that the second channel be the D channel of an ISDN line, which is clearly not taught or suggested by Peterson or the other cited prior art. One of the advantages of using the D channel is that the telephone number is transferred faster, making parallel use of the B and D lines. The prior art does not recognize this problem and solution. Therefore, a person of ordinary skill in the art would not have been led to Applicant's claimed invention based on Sussman and Peterson.

Moreover, there is no suggestion or motivation for combining Sussman and Peterson. Sussman discloses downloading a telephone directory from a central facility at predetermined periods over a conventional telephone system to update a private on-line directory database. Peterson discloses automatic dialing of a telephone number received from directory assistance in a cellular telephone system. The Examiner alleges that the motivation to combine would have been "the purpose of providing digital communication capability." This "purpose," however, is too broad or general and would not have led a person of ordinary skill in the art to the specific invention claimed. There is no specific motivation for combining an ISDN feature of Peterson with Sussman to arrive at Applicant's claimed invention.

Claims 2-4, 6 and 7 depend from claim 1. Therefore, claims 2-4, 6 and 7 are patentably distinguishable over the prior art for at least the reasons that claim 1 is patentably distinguishable over the prior art.

Claim 9 depends from claim 8. Therefore, claim 9 is patentably distinguishable over the prior art for at least the reasons that claim 8 is patentably distinguishable over the prior art.

***Rejection of Claim 5 Under 35 U.S.C. § 103(a)***

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sussman, Peterson and further in view of Rondeau. This rejection is traversed.

Claim 5 depends from claim 1. Therefore, claim 5 is patentably distinguishable over the prior art since claim 1 is patentably distinguishable over the applied art, and Rondeau fails to bridge the deficiencies emphasized above.

Further, claim 5 requires that the second channel be an organizational channel in a global system for mobile (GSM). The Examiner acknowledges that Sussman and Peterson do not disclose that the second channel is an organizational channel in a global system for mobile (GSM). However, the Examiner alleges that Rondeau discloses a GSM, that a GSM includes as a second channel as an organizational or control channel, and that therefore, it would have been obvious to modify Rondeau such that the organizational channel be used to transmit the telephone number in numeric string form over the second channel.

Rondeau and the cited prior art do not teach or suggest that the telephone number for a desired subscriber be transmitted over the organizational channel, as required by claim 5. Further, the use of the organizational channel in this way provides advantages, analogous to those described above, with respect to the D and B lines of an ISDN line. This problem and

solution are not disclosed in the prior art and therefore there is no motivation for Applicant's claimed invention based on the prior art.

Claims 12-14 are added. These amendments contain no new matter. (See, e.g. Fig. 1; Specification, pages 4-7.)

Claim 12 requires a first channel for voice transmission and a second channel for data transmission, and transmitting a telephone number in the form of a numeric string on the second channel. Further, claim 14 requires a first channel for voice transmission and a second channel for data transmission, and receiving on the second channel a telephone number. The prior art does not disclose or suggest these features. Therefore, for at least these reasons, claims 12 and 14 are patentably distinguishable over the prior art.

Claim 13 depends from claim 12 and thus incorporates all of the recitations thereof. Therefore, claim 13 is patentably distinguishable over the prior art for at least the reasons that claim 12 is patentably distinguishable over the prior art.

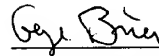
In view of the foregoing discussion, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

**PRELIMINARY AMENDMENT**  
U.S. Application No. 09/199,320

**Q51986**

Respectfully submitted,



George Brieger  
Registration No. P-52,652

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE



**23373**

PATENT TRADEMARK OFFICE

Date: March 12, 2003